

**Remarks/Arguments:**

The pending claims are 20, 22-25, 27-33, 39, 41, 43-49, and 54-57.

Applicants note with appreciation the decision in paragraph 1 of the Office Action affording applicants an opportunity to continue prosecution of this application in lieu of an appeal. Applicants' response follows.

Applicants also note with appreciation the Examiner's indication that claims 27-30 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Paragraph 6 on page 4 of the Office Action has rejected claims 56-57 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action contends that the specification does not describe hoops lying in a plane perpendicular to the longitudinal axis. Applicants respectfully disagree and traverse the rejection.

Claim 56 recites, in part:

wherein the vertices of each hoop pointed in the axial direction lie in a common plane perpendicular to the axis of the tubular member.

The specification describes exemplary embodiments of the foregoing feature, for example:

the wire may be of an entirely novel configuration, namely one in which the wire forms a plurality of hoops such that the plane of the circumference of each hoop is substantially perpendicular to the longitudinal axis of the stent. (page 9, lines 15-19)

It will [be] appreciated that an advantage of this novel arrangement is that the planes of the hoops are not skewed with respect to the longitudinal axis of the stent; the longitudinal ends of the stent are "square" to said longitudinal axis, so that when the stent is caused or allowed to expand in situ there is substantially no twisting of the stent as it shortens in length. (page 10, lines 1-7)

Each hoop 20 is wound onto mandrel 46 such that the plane of the circumference of each hoop 20 is substantially perpendicular to the longitudinal axis of the mandrel. (page 23, lines 20-23)

Two embodiments of such straight stents are described therein, each comprising axially aligned stent requests, each of the requests comprising one or more adjacent hoops, perpendicular to a common axis.... (page 44, lines 19-23)

Since the above cited passages provide ample support for claims 56 and 57, and because various embodiments of the subject feature are illustrated through the figures (see, e.g., Figs. 1A, 1B, 2A, 2B, 3, 4A, 5-7, and 15-20), applicants request that this rejection be withdrawn.

In paragraph 2, pages 4-5 of the Office Action, claims 20, 22-24, 31-33, 41, 54 and 55 have been rejected under 35 U.S.C. § 102(e) as anticipated by Cragg (U.S. Patent No. 5,405,377). The rejection is respectfully traversed. Independent claim 54 recites that "each of said hoops [are] oriented in a plane substantially perpendicular to the longitudinal axis of the stent." The rejection in paragraph 2, pages 4-5 and the Response to Arguments in paragraph 2, page 2, lines 16-20 are identical to the rejection and Response to Arguments in the January 26, 2004 Office Action. Accordingly applicants incorporate by reference the arguments they made in their appeal brief filed on December 16, 2004.

The only new Response to Arguments occurs in paragraph 2 on pages 2-3 of the Office Action which contends that the specification "has not defined the scope of 'substantially perpendicular' so the broadest reasonable interpretation may include at least 90, 80, 70 or 60 degrees from the longitudinal axis."

This statement implies that the specification does not contain a written description of the invention recited in claim 54; but no rejection of claim 54 has been made under Section 112 (though claims 56-57 have been rejected under Section 112). Applicants' specification demonstrates that one skilled in the art would know what is meant by the term "substantially perpendicular." Specifically, the meaning of this term is made clear in the specification by reference to the exemplary passages and figures cited above and to the statement in the specification that the substantially perpendicular configuration is different from Cragg's helical configuration. If the Office Action is objecting to the use of the term "substantially," such an objection would be improper and without basis. In fact, MPEP 2173.05(b) expressly approves

the term "substantially" and states that "substantially" is sufficiently definite. For example, this section of the MPEP cites a case, with approval, where "the limitation 'which produces substantially equal E and H plane illumination patterns' was definite because one of ordinary skill in the art would know what was meant by 'substantially equal.'"

In light of the Supreme Court decision in *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999) and the decision of the U.S. Court of Appeals for the Federal Circuit in *In re Gartside*, USPTO action, findings and conclusions must be supported by substantial evidence. "Substantial evidence" is more than a mere scintilla. "It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." MPEP 1206.01. The Office Action has not produced any evidence that a person skilled in the art would ignore the clear teaching in applicants' specification and conclude that the helical hoops in the Cragg device were "substantially perpendicular to the longitudinal axis of the stent." In other words, any conclusion that the hoops of the Cragg device are "substantially perpendicular" would directly contradict the clear teaching of applicants' specification, and the USPTO has not produced any substantial evidence to support such a conclusion.

For the foregoing reasons, Cragg fails to anticipate claim 54 or claims 20, 22-24, 31-33, 41, or 55, each of which is directly or indirectly dependent upon claim 54. Accordingly, withdrawal of the rejection based on Cragg is respectfully requested.

In paragraph 3, page 5 of the Office Action, claims 20, 22-24, 31, 54-55 have been rejected under 35 U.S.C. § 102(e) as anticipated by Fontaine (U.S. Patent No. 5,370,683). The rejection is respectfully traversed. The rejection in paragraph 3, page 5 and the Response to Arguments in paragraph 3, page 3 of the Office Action are virtually identical to the rejection and Response to Arguments in the January 26, 2004 Office Action, except for three differences. Accordingly, applicants incorporate by reference the arguments they made in their appeal brief filed on December 16, 2004.

The first difference is that the current Office Action has rejected fewer claims based upon Fontaine than were rejected in the previous Office Action, and applicants appreciate the withdrawal of the rejection based on Fontaine with respect to some of the pending claims. The second difference is that the current Office Action has eliminated an argument, contained in the January 26, 2004 Office Action, that Figures 13-16 of Fontaine clearly show embodiments in which the vertices align in a common plane perpendicular to the longitudinal axis of the stent.

Applicants appreciate the withdrawal of that argument based on Fontaine. The third difference is that the current Office Action adds the argument that the specification has not defined the scope of "substantially perpendicular," and applicants incorporate by reference the arguments made above in responding to this rejection based on Cragg.

For the above reasons, the Fontaine reference fails to anticipate claim 54 as well as claims 20, 22-24, 31, and 55 which are directly or indirectly dependent upon independent claim 54. Accordingly, withdrawal of the rejection based on Fontaine is respectfully requested.

In paragraph 4, page 5, claims 20, 22-25, 39, 43, 44, 47, 54-55 have been rejected under 35 U.S.C. § 102(b) as anticipated by Wolff (U.S. Patent No. 5,104,404). The rejection is respectfully traversed. The Office Action has not presented any new grounds in support of this rejection either in paragraph 4, page 5 or in the Response to Arguments in paragraph 4, page 3 of the Office Action. Accordingly, applicants incorporate by reference the arguments they made in their appeal brief filed on December 16, 2004. Based on those arguments, these claims are not subject to rejection under 35 U.S.C. § 102(b) as anticipated by Wolff and withdrawal of the rejection is respectfully requested.

Claims 20, 22-24, 31, 39, and 54 have been rejected under 35 U.S.C. § 102(b) as anticipated by Furui (JP 4-25755), a reference that is wholly in Japanese. This new rejection is respectfully traversed. In discussing the use of foreign language documents that the USPTO relies upon in support of a rejection, MPEP 706.02 states:

If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.

Claim 54 recites, in part, "means for securing an apex of one hoop to a juxtaposed apex of a neighboring hoop." Because the USPTO has not obtained an English translation of Furui, the Office Action fails to identify any disclosure in Furui of a means for securing an apex of one hoop to a *juxtaposed* apex of a neighboring hoop. Nevertheless, applicants have obtained an English language translation, which is believed to be accurate and which is attached to the present Request for Reconsideration.

Page 3 of the English language translation shows that Furui sought to devise a stent that could "perform its action fully even when" part of the stent is bent. Furui also sought to devise

a stent that could "perform the functions of a stent even when it is placed in an affected part with a pronounced curvature." Furui explained how it solved the problem on page 3 in the section identified as "Means of Solving the Problems." Specifically, Furui solved the problem by making a stent comprising two cylinders. The valleys of one of the cylinders "are connected by wires to the peaks of the other cylinder; the connecting part of at least one of these peaks is engaged by a ring; and rings are formed in the outer peaks or valleys." The wires also have small rings that engage the peaks and valleys. As stated on page 4 of the translation, "[s]ince the peaks and valleys of the waves of the wave-shaped wire of the recoverable stent of the present utility model are connected to a wire which has small rings 3, the stent does not close up when it is placed in an affected part of a blood vessel, etc., which is bent."

Furui fails to disclose a stent structure in which apices are juxtaposed to one another. Instead, the ringed wire connector structure disclosed in Furui spaces peaks and valleys from one another. No two apices of the Furui reference are arranged close together or side-by-side. Because Furui fails to disclose apices that are arranged in juxtaposition to one another, claims 20, 22-24, 31, 39 and 54 are not subject to rejection under 35 U.S.C. § 102(b) as anticipated by Furui and withdrawal of the rejection of those claims is respectfully requested. If the USPTO is unsure of applicants' translation of Furui, the USPTO is invited to provide its own translation of Furui as required by MPEP 706.02.


Claims 45, 46, 48, 49 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Wolff in view of Piplani (U.S. Patent No. 5,824,039). The rejection is respectfully traversed. The Office Action has not presented any new grounds in support of this rejection in paragraph 7, pages 6-7 of the Office Action. Accordingly, applicants incorporate by reference the arguments they made in their appeal brief filed on December 16, 2004. Based on those arguments, these claims are not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Wolff in view of Piplani.

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Reply to Office Action of March 31, 2005

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In view of the foregoing remarks, it is respectfully submitted that the application is in proper form for allowance. A Notice of Allowance is therefore respectfully requested.

Respectfully submitted,



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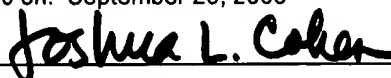
Enclosure: Translation for Japanese Publication No. 4-25,755

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